

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ETH5092 [13926]

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

10/674,653

Filed

09-30-2003

First Named Inventor

Marc Feinberg

Art Unit

3773

Examiner

Melissa K. RYCKMAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 33,020

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

MICHAEL J. MLOTKOWSKI

Typed or printed name

(703) 584-3275

Telephone number

September 17, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Marc E. Feinberg	Confirmation No. 4786
Serial No.:	10/674,653	Art Unit: 3773
Filed:	September 30, 2003	Examiner: RYCKMAN, Melissa K.
For:	TISSUE APPROXIMATION DEVICE	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Advisory Action of August 26, 2008, Applicants submit a Pre-Appeal Brief Request for Review, in combination with a Notice of Appeal and a petition for a three (3) month extension of time, submitted on even date herewith.

REMARKS

Rejection under 35 U.S.C. §102(b) over Taylor et al.

Claims 5, 6, 8, 38-42 and 46-48 stand rejected under 35 U.S.C. §102 (b) as anticipated by Taylor et al. (U.S. Patent No. 6,394,951). Applicants traverse this basis for rejection and respectfully request reconsideration and withdrawal thereof.

The Office Action states that Taylor teaches a tissue approximation device having two elongate arms 3, an attachment means 144, adhesive pads 4 movably connected by elements 18 and 19 on at least a portion of the elongate arms, and a locking means 181 as claimed. Reference is made to the embodiments represented in Figs. 31a and 31b. At page 4 of the outstanding Office Action, the Examiner states “the adhesive pad is rotatable around the ball about at least two axes (slight rotation is possible along two axes)”.

Applicants respectfully traverse the Examiner’s finding on this point, which is entirely unsupported by the language in Taylor et al. describing elements 18 and 19 (col. 14, lines 20-37). Taylor et al. describe Fig. 2 as having “snap-in member 16”, which has a post 18 formed on top of member 16, and a port 19 disposed in the body of contact member 1. Nowhere do Taylor et al. disclose or suggest that snap-in member 16 should be rotatable, or even movable, as suggested by the Examiner. The Examiner’s finding is entirely unsupported by the cited reference, and as such, the rejection under 35 U.S.C. §102(b) is literally unfounded. Withdrawal of the rejection is requested on this basis alone.

At page 6 of the Final Office Action, the Examiner opines:

The applicant generally argues the following regarding the pending claims ... Taylor does not teach a movable ball and socket connection. The examiner’s position is that the ball and socket (18 and 19, Fig. 2) of Taylor is movable to a small degree, it is capable of being moved. (Emphasis added).

The Examiner's position is speculative at best, and disingenuous at worst. Taylor et al. never describe elements 18 and 19 as a "ball and socket", but instead as parts of a "snap-in member". The Examiner's characterization of elements 18 and 19 as a "ball and socket" is strictly an impermissible hindsight reconstruction of the present invention, derived from reading of the present specification. The only manner in which elements 18 and 19 could cooperate as a "ball and socket" would be if post 18 were not inserted completely through port 19, such that the surface of post 18 would swivel against the inner ring of port 19, in which case snap-in member 16 would not be "affixed" to contact member 1, as required in Taylor et al. (col. 14, line 21).

Likewise, the Examiner's position that Taylor's elements 18 and 19 would be movable relative to one another is unfounded, both in the Taylor et al. specification (as stated above), and from the view of the skilled artisan. In view of the extremely delicate nature of the surgery to be performed as set forth in Taylor et al., i.e. open heart surgery (col. 14, lines 38-40), the skilled artisan would not expect the Taylor et al. device to be designed or made such that unwanted movement could occur. Such movement would be very detrimental to the surgical procedure, where the utmost accuracy in positioning the Taylor et al. device would be required.

Additionally, the Examiner's proposition that the Taylor et al. device would be "movable to a small degree" ignores the plain language of claim 8, wherein Applicants specify "the adhesive pad is rotatable around the ball about at least two axes". Even a cursory review of Taylor et al.'s Fig. 2 would reveal that no rotation, let alone rotation about at least two axes would be available. Presuming that the x and y axes are the horizontal and vertical axes within the plane of the page, and that the z axis would extend out of the page, snap-in member 16 is clearly restrained from rotation about the z axis by the length and lower surface of contact member 1, and restrained against rotation about the y axis by the linear arrangement of both snap-in posts 18, i.e. there is no pivot point for such rotation.

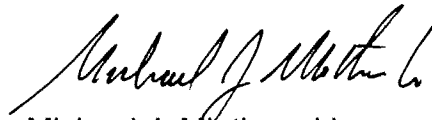
The Examiner's stated position that the device would be movable to a small degree must presume a sloppy fit of the snap-in member and posts 18 within ports 19. As stated above, such an interpretation of the Taylor et al. device is unwarranted, not only by the literal language of the reference, but also by the expectations of the skilled artisan as to the requirements for devices used in extremely exacting open heart surgery. Further, the skill in the arts of molding (if made of plastic) or machining is well-beyond the point of making a sloppy fitting snap-in connection, as presumably argued by the Examiner. As evidence, Applicants attach hereto an article entitled "Snap-Fit Joints for Plastics – A Design Guide" from Bayer Material Science, which illustrates the exacting nature of the design considerations for snap-fit joints.

There is no reason to expect that posts 18 would be movable within ports 19 of Taylor et al.

Withdrawal of the rejection is requested.

It is submitted that the application is in condition for allowance. Should further issues requires resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Michael J. Mlotkowski
Reg. No. 33,020
Attorney for Applicants
703-584-3270

DATED: September 17, 2008

CORRESPONDENCE ADDRESS:
Roberts Mlotkowski Safran & Cole
P.O. Box 10064
McLean, VA 22102